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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,338	06/24/2003	Arindam Datta	ETH1685CIP	8257

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EXAMINER
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HO, UYEN T

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/602,338	<b>Applicant(s)</b> DATTA ET AL.	
	<b>Examiner</b> Tan-Uyen T. Ho	<b>Art Unit</b> 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/24/03; 4/14/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statements (IDS) submitted on 6/24/03 and 4/14/05, are being considered by the examiner.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,338,739. Although the conflicting claims are not identical, they are not patentably distinct from each other because they contains the same subject matters or the subject matters of the application are obvious variants of the claimed invention in the patent.
4. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,423,092. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the subject matters of the application are obvious variants of the claimed invention in the patent and/or the addition claimed subject matters of the application are well known in the art.

5. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/256,942. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both contain the same subject matters and/or the subject matters of the application are obvious variants of the claimed invention in the patent, and/or the subject matters of the application are obvious of the combination of the claimed invention of the patent in view of well-known structure in the art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-22 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,537,312. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both contain the same subject matters and/or the subject matters of the application are obvious variants of the claimed invention in the patent, and/or the subject matters of the application are obvious of the combination of the claimed invention of the patent in view of well-known structure in the art.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (W098/56312) in view of Jamiolkowski et al. (4,889,119). Wang et al. teach a stent formed of a material comprising an inner layer covered by an outer layer, both layers being of a biodegradable polymeric composition and exhibiting different time periods of degradation, wherein the degradation rate of the inner layer can be slower or faster than the degradation rate of the outer and wherein the inner core being made from polylactide, polyglycolide, polycaprolactone and outer layer may be selected from materials such as polycaprolactone, Polyortho esters, polyanhydrides, PGA/PLA, PEO/PLA (page 6-7). Wang et al. disclose any of the materials used for the inner layer may be used for the outer layer with appropriate arrangement made for degradation, such as thickness, for example (page 5, lines 1 1-12). Wang et al. also disclose the outer layer including drug coating material as claimed (see pages 8 and 10) and the stent in helical structure. However, Wang et al. do not teach the polymer composition of the inner core comprising a blend composition as claimed. Jamiolkowski et al. disclose a biodegradable polymer comprising a blended composition as claimed for use to make surgical devices so that the surgical devices retain a substantial proportion of their initial strength during critical wound healing period (col. 3, lines 35-42) and rapid soften so that they become impalpable after used. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the material of the outer layer of Wang et al.'s stent with the material as disclosed by Jamiolkowski et al.. Doing so would amount to mere substitution of one material for another within the same art that perform equally well in Wang et

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al.'s stent. Furthermore, it would have been obvious too one having ordinary skill in the art at the time the invention was made to make the outer layer of Wang et al.'s stent with the material as claimed in order to provide the outer section with a great initial strength to support a body lumen wall during critical treatment period and rapid soften so that they become impalpable after used.

Regarding to the fiber cross-section and the diameter of stent structure, the over stent structure as claimed are well known in the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the stent structure to have configuration as claimed in order to provide a shape or structure of the stent accommodating with the size and shape of a body lumen.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703- 872-9306.



Tan-Uyen T Ho  
Primary Examiner  
Art Unit 3731

March 6, 2006